



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

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| SERIAL NUMBER | FILING DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NO. |
|---------------|-------------|-----------------------|---------------------|
| 06/287,141 | 07/27/81 | GILLET | |

FREELING E. BAKER
110 W. C ST., STE. 1305
SAN DIEGO, CA 92101

| EXAMINER | |
|------------|--------------|
| WATSON, R. | |
| ART UNIT | PAPER NUMBER |
| 323 | |

DATE MAILED: 01/26/83

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☒ Responsive to communication filed on Nov 18, 1982 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449 | 4. <input type="checkbox"/> Notice of informal Patent Application, Form PTO-152 |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474 | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 4-6 and 11 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☒ Claims 1-3 and 7-10 have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 4-6 and 11 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.
8. ☐ Allowable subject matter having been indicated, formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. These drawings are ☐ acceptable;
☐ not acceptable (see explanation).
10. ☐ The ☐ proposed drawing correction and/or the ☐ proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved. ☐ disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.

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The amendment filed November 18, 1982 amending page 2, line 25 is objected to under 35 U.S.C. 132 because it introduces new matter into the specification. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:
"non elastic".

Applicant is required to cancel the new matter in the response to this Office action.

The specification is objected to under 35 U.S.C. 112, first paragraph, as the specification as originally filed, does not provide support for the invention as now claimed. For example the original disclosure does not recite "non elastic". This paragraph of the statute requires that the specification shall contain a written description of the invention and of the manner and process of making and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 4-6 and 11 are rejected under 35 U.S.C. 112, first paragraph, for the reasons set forth in the objection to the specification. The claimed

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11 and 4-6 are rejected under 35 U.S.C. 103 as being unpatentable over Whiteford. Whiteford teaches that sheets of polypropylene (column 4, line 61), 8 mils thick (column 5, line 8), may have a rim (column 2, lines 68) and can be used as covers for the bottom of receptacles. To cut the sheet into any shaped configuration to cover an entire receptacle or to cut a flat sheet and cover only the bottom of a receptacle is clearly an obvious matter of design choice. Although 8 mil thickness is disclosed, a 9 mil thickness would be an obvious variation. No patentable weight has been given to the intended use recited in the claims.

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analogous sheets of polypropylene. Simmons and Dunlap show bottom covers of rectangular and circular shape.

Applicants remarks have been given careful consideration but fail to overcome the above rejection. The new references clearly show the newly claimed feature of the sheet being non-elastic although this feature is deemed to be new matter. Applicant apparently is relying upon the intended use language in the claims for patentability. The intended use of the device has no patentable significance. The claim 1 recites no more than a roll of stock sheet material of polypropylene 9 mils thick which is clearly well known. The dependent claims recite little more than cutting this roll of material into a desired shape. Rims on sheet materials are further well known and obvious as evidenced by the references employed in the rejection.

Applicant's amendment necessitated the new grounds of rejection. Accordingly, THIS ACTION IS MADE FINAL. See MPEP 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

TO SEPARATE, HOLD TOP AND BOTTOM EDGES, SNAP-APART AND DISCARD CARBON

| | | | | |
|-----------------------------|--|-------------------------|-----------------------|--|
| FORM PTO-892 (REV. 3-78) | U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE | SERIAL NO. 287,191 | GROUP/ART UNIT 323 | ATTACHMENT TO PAPER NUMBER 5 |
| NOTICE OF REFERENCES CITED | | APPLICANT(S) Gillett | | |

U.S. PATENT DOCUMENTS

| * | DOCUMENT NO. | DATE | NAME | CLASS | SUB-CLASS | FILING DATE IF APPROPRIATE |
|---|--------------|-------|--------------|-------|-----------|----------------------------|
| A | 3305124 | 2/67 | Whiteford | 220 | 405 | |
| B | 3407161 | 10/68 | Rundle | 428 | 220 | |
| C | 4263355 | 4/81 | Sarkisian | 428 | 192 | |
| D | 2709905 | 6/55 | Dunlap | 220 | 405 | |
| E | 1979578 | 11/34 | Simmons | 217 | 3R | |
| F | 3918995 | 11/55 | Palmer et al | 428 | 220 | |
| G | | | | | | |
| H | | | | | | |
| I | | | | | | |
| J | | | | | | |
| K | | | | | | |

FOREIGN PATENT DOCUMENTS

| * | DOCUMENT NO. | DATE | COUNTRY | NAME | CLASS | SUB-CLASS | PERTINENT SHTS. DWG. | PP. SPEC. |
|---|--------------|------|---------|------|-------|-----------|----------------------------|--------------|
| L | | | | | | | | |
| M | | | | | | | | |
| N | | | | | | | | |
| O | | | | | | | | |
| P | | | | | | | | |
| Q | | | | | | | | |

OTHER REFERENCES (Including Author, Title, Date, Pertinent Pages, Etc.)

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| R | |
| S | |
| T | |

All communications respecting this application should give the serial number, date of filing and name of the applicant.



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PAPER NO. 9

MAILED

AUG 01 1983

GROUP 320

[Serial No. 287,141 07/27/81]
Marian E. Gillett

Before the Board of Appeals

Freling E. Baker
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San Diego, California 92101

Freling E. Baker
For Appellant

Examiner's Answer

This is an appeal from the final rejection of claims 4-6 and 11.

A correct copy of the appealed claims appears on page 2 of the appellant's brief.

THE INVENTION

The invention is adequately described on page 3 of appellant's brief.

THE REFERENCES OF RECORD RELIED ON

| | | |
|-----------|-----------|---------|
| 3,305,124 | Whiteford | 2/21/67 |
| 3,811,989 | Hearn | 5/21/74 |

THE REJECTION

The amendment filed November 18, 1982 amending page 2, line 25 was objected to under 35 USC 132 because it introduced new matter into the

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elastic". Applicant is required to cancel the new matter.

The specification is objected to under 35 U.S.C. 112, first paragraph, as the specification, as originally filed, does not provide support for the invention as is now claimed. For example, the original disclosure does not recite "non elastic". This paragraph of the statute requires that the specification shall contain a written description of the invention and of the manner and process of making and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 4-6 and 11 stand rejected under 35 U.S.C. 112, first paragraph, for the reasons set forth in the objection to the specification. The claimed recitation "non elastic" constitutes new matter which is wholly unsupported subject matter.

Claims 11 and 4-6 stand rejected under 35 U.S.C. 103 as being unpatentable over Whiteford. Whiteford teaches that sheets of polypropylene (column 4, line 61), 8 mils thick (column 5, line 8), may have a rim (column 2, line 68) and can be used as covers for the bottom of receptacles. Although 8 mil thickness is

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patentable weight has been given to the intended use recited in the claims.

Claims 4-6 stand rejected under 35 U.S.C. 103 as being unpatentable over Whiteford in view of Hearn. Alternatively, to employ a decorative rim on the cover would be obvious in view of Hearn.

RESPONSE TO ALLEGATIONS IN APPELLANT'S BRIEF

With regard to the new matter rejection under 35 USC 112, first paragraph, applicant's sole argument is that the recited "non-elastic" limitation is an "inherent characteristic of the specified material". It is respectfully submitted that appellant's position in this regard is in error. It is well known to those skilled in the art that the final characteristics of a plastic material are influenced by such factors as the curing temperature, curing time, curing agents, filler materials, whether or not the material is reinforced with a fiber, the type of fiber reinforcement, and whether or not the material is compressed during curing. Accordingly, the term "non-elastic" is not an inherent characteristic of the claimed material but is influenced by other processing factors. The recitation "non elastic" is wholly unsupported in the disclosure and is new matter.

With regard to the 35 USC 103 rejection of record appellant remarks that the Whiteford reference "does not disclose or suggest the applicant's specific